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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,006	03/28/2005	Shirou Sawa	2005_0232A	1756

513 7590 06/24/2010

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EXAMINER	
JAGOE, DONNA A	

ART UNIT	PAPER NUMBER
1619	

NOTIFICATION DATE	DELIVERY MODE
06/24/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/525,006	SAWA ET AL.	
	Examiner	Art Unit	
	Donna Jagoe	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-51,53-56,58-62 and 64-68* is/are pending in the application.

4a) Of the above claim(s) *61 and 62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-51,53-56,58-60 and 64-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/8/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 41-51, 53-56, 58-62 and 64-68 are pending in this application. Claims 61 and 62 are withdrawn. Claims 41-51, 53-56, 58-60 and 64-68 are rejected.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 8, 2010 has been considered by the examiner. See attached 1449.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Desai et al. U.S. Patent No. 5,603,929.

Desai et al. teach an ophthalmic composition comprising bromfenac (2-amino-3-(4-bromobenzoyl)phenylacetic acid) and its ophthalmically acceptable salts, esters, amides or prodrugs thereof (column 3, lines 13-29, claims 4 and 7) and polysorbates such as tweens and tyloxapol and further comprising boric acid buffer (column 2, lines 18-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 43-51, 53-56, 58-60 and 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al U.S. Patent No. 5,603,929 as applied to claims 41 and 42 above, and further in view of Yanni et al. U.S. Patent No. 5,475,034 and Hellberg et al. U.S. Patent No. 5,998,465.

Desai et al. teach an ophthalmic composition comprising bromfenac (2-amino-3-(4-bromobenzoyl)phenylacetic acid) and its ophthalmically acceptable salts, esters, amides or prodrugs thereof (column 3, lines 13-29, claims 4 and 7) and polysorbates such as tweens and tyloxapol and further comprising boric acid buffer (column 2, lines 18-44). It does not teach the concentration of about 0.01% to about 0.5% w/v. Yanni et al. teach 2-amino-3-4-bromobenzoylphenylacetamide (compound 15, column 9) and teach topically administrable ophthalmic compositions such as solutions, gels or ointment in concentrations of from about 0.01 to about 0.5% preferably (column 15, lines 1-55). Yanni et al. teach tyloxapol but it does not recite the specific amount. Hellberg et al. teach tyloxapol in an ophthalmic solution comprising NSAIA moieties include bromfenac (col. 3, line 57; claim 5); examples 2 and 3 (col. 11) in an amount of 0.01 to 0.05 % w/v (see examples 2 and 3, column 11). Addressing instant claims 48, 49, 55, 56, 59 and 60 drawn to the addition of one or more additives selected from a preservative, buffer, thickener, stabilizer, chelating agent and pH controlling agent, Desai et al. teach preservatives such as boric acid (column 2, lines 18-22), and benzalkonium chloride (column 3, lines 30-35), viscosity modifying agents (thickeners) such as polyvinyl pyrrolidone (column 3, lines 46-57), chelating agents (column 3, line 43) and pH controlling agent such as sodium hydroxide (see formulation example 1,

column 4). The pH is adjusted to 7.4 (see example 1, column 4) which is encompassed by instant claim 50 drawn to a pH of from about 7 to 9. Addressing instant claim 51, drawn to a pH from about 7.5 to about 8.5, Desai teach a pH of about 7.4 as noted supra. A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Addressing instant claim 64, Desai et al. teach an ophthalmic composition comprising bromfenac (2-amino-3-(4-bromobenzoyl)phenylacetic acid) and its ophthalmically acceptable salts, esters, amides or prodrugs thereof (column 3, lines 13-29, claims 4 and 7) and tyloxapol and further comprising boric acid buffer (a.k.a. sodium tetraborate) (column 2, lines 18-44), Benzalkonium chloride (column 3, line 34), polyvinyl pyrrolidone (column 3, line 52). It does not teach EDTA sodium salt and sodium sulfite, however, Yanni et al. teach ophthalmic solutions comprising 2-amino-3-4-bromobenzoylphenylacetamide (compound 15, column 9) and further teach incorporation of sulfites such as sodium (column 2, lines 12-14) and EDTA sodium salt (disodium EDTA) (see column 16, line 57 and column 17, line 5). It would have been obvious to employ said sodium sulfite and EDTA sodium salt in an ophthalmic formulation motivated by the teaching of Yanni et al. who disclose disodium EDTA and sodium sulfite in ophthalmic formulations of bromfenac for the purpose of stabilizing the solution (column 2, lines 2-14).

Double Patenting

Claims 41-51, 53-56, 58-60 and 64-68 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No. 11/755662.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application contains claims drawn to method of treating pain and/or inflammation associated with an ocular condition, by administering the aqueous solutions of the instant claims. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the formulations of the instant claims in the methods of the copending application, since the claims recite that the formulations are eye drops, and the instant abstract also teaches some of the conditions treated of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claims are allowed.

Response to Arguments

Applicant's arguments with respect to claims 41-51, 53-56, 58-60 and 64-68 have been considered but are moot in view of the new ground(s) of rejection. Applicant asserts that the Hellberg reference teaches bifunctional ester compounds having both anti-inflammatory and anti-oxidant activity. The rejection has been withdrawn, however

Hellberg et al. is relied on supra for its teaching of the amount of tyloxapol incorporated into the ophthalmic solution. The double patenting rejection is maintained and hereby repeated.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Friday from 8:00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on (571) 272-0871. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YVONNE L. EYLER/
Supervisory Patent Examiner, Art Unit 1619

Donna Jagoe /D. J./
Examiner
Art Unit 1619

June 15, 2010